

### **REMARKS**

In the Official Action, the Examiner rejected all pending claims 1-35. In the present response, Applicant respectfully traverses the rejection, as discussed below in greater detail. Accordingly, Applicant respectfully requests reconsideration and allowance of all pending claims.

#### **Rejection Under 35 U.S.C. § 103**

Claims 1-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tavor et al. (U.S. Patent No. 6,070,149) in view of Henley (U.S. Patent Pub. No. U.S.2002/0065758A1) and Doi et al. (U.S. Patent No. 5,224,177). Applicant respectfully traverses this rejection.

The pending claims are patentable because the Examiner has not established a *prima facie* case that the claims are obvious in view of the cited references. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

In the Office Action, the Examiner asserted that the Tavor et al. reference discloses all of the claimed subject matter except for the product being a CR system. To cure this deficiency, the Examiner relied on the Henley reference to teach the product being a medical service or product and the Doi et al. reference to teach that a CR system can be purchased. Furthermore, in the Response to Arguments portion of the Office Action, the Examiner stated that:

In this case, the Henley reference is not being used to teach the specifics of the online bidding system for acquiring medical services and products, but rather to teach that medical services and products can be acquired online, since Taylor does not mention the type of product that is used. The fact that the systems differ is irrelevant because no specific method used in the service in Henley is combined with the Taylor reference. Therefore, the rejection is deemed proper and is maintained.

However, in contrast to the Examiner's assertion, in combining prior art references, the references must be considered as a whole for what they teach. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As such, in combining the prior art references, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d. 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Thus, the Examiner is not free to pick and choose among the subject matter of the Henley and Doi references to find subject matter that supports the Examiner's arguments, while rejecting the subject matter that contradicts or opposes the Examiner's argument. Accordingly, there is no support in the law for the Examiner's assertion that: "The fact that the systems differ is irrelevant because no specific method used in the service in Henley is combined with the Taylor reference." In fact, as noted above, the opposite is the case.

In fact, the references cited by the Examiner actually lead away from the proposed combination and are internally inconsistent with one another. The Tavor et al. reference describes a method for enabling users over a network to interact with an interactive sales representative system for providing sales guidance. *See* Tavor et al., col. 1, lines 5-10. The Tavor et al. reference describes the problems with previous web-based ordering systems that do not provide advice, knowledge, experience to the user. *See* Tavor et al., col. 1, lines 45-50. As such, the Internet sales representative system of the Tavor et al. reference interacts with the user to advise, guide, consult, and suggest different items for sale to the user. *See* Tavor et al., col. 3, lines 19-27. The Tavor et al. system uses rules, which are a set of conditions, to guide the user through the process of purchasing the product. *See* Tavor et al., col. 5, line 56-col. 6, line 5. As such, the user in the Tavor et al. system *does not know of a specific product*, but is guided through the use of questions by the system to a specific product. *See* Tavor et al., col. 3, lines 31-41. By answering the questions, the system is able to suggest and guide the user to products for sale.

In contrast to the Tavor et al. system, the Henley reference describes an online bidding system for acquiring medical services and products. *See* Henley, paragraphs 6 and 19. In the Henley reference, the user *knows of a specific medical service or product*. The Henley system matches the specific medical service being requested with that *same specific product* being offered by medical facilities to provide possible matches between the patient/client and seller of a specific medical service. *See* Henley, paragraph 38. Clearly, the patient/client *is not guided to a service* because the patient/client is looking for a specific medical service. *See* Henley, paragraphs 31 and 32. As a result, the Henley reference does not use a plurality of questions to get to a specific medical service or product because the patient knows the specific medical service or product sought. As a result, the Henley system is actually contradictory to and inconsistent with the Tavor et al. system because the user knows the medical service that is desired and is not guided to a product. Thus, the references, considered as a whole, as they must be, are not subject to combination.

The Doi et al. reference does nothing to cure these deficiencies in either the Henley or the Tavor et al. references because the Doi et al. reference is related to a method for correcting a non-linear characteristic of an image. The Examiner only used the Doi et al. reference to teach that a CR system can be purchased. While it is clear that a CR system can be purchased, generally, this fact is not relevant to the claimed subject matter. Because the Doi et al. reference does not disclose a web-based system, it does nothing to cure the deficiencies of the Henley and Tavor et al. references.

Accordingly, because the references in their entirety actually lead away from the combination and are inconsistent with one another, the Examiner has failed to show a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the cited references. As such, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, independent claims 1, 15, 26 and 31 and their respective dependent claims are believed to be patentable over Tavor et al., Henley, and Doi et al.

**Conclusion**

In view of the remarks set forth above, Applicant respectfully requests allowance of the pending claims 1-35. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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